

Remarks

Applicant has filed an RCE and this Amendment in response to the Office Action dated June 3, 2003. New dependent claim 16 has been added. Claims 1-16 are currently pending. Reexamination and reconsideration are respectfully requested.

Claims 1-15 were rejected by the Examiner under 35 U.S.C. 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0022366 A1 to Cabral, Jr. et al. (hereinafter "Cabral"), in combination with of U.S. Patent No. 5,780,889 to Hu et al. (hereinafter "Hu") and U.S. Patent Application Publication No. 2001/0029067 A1 to Hirano (hereinafter "Hirano"). The rejection is respectfully traversed.

It is respectfully submitted that the references have been improperly combined and that the rejection of the claims based upon this improper combination should be withdrawn.

The Examiner appears to have cited Cabral as teaching a semiconductor device including a SOI film having a thickness that "is 0.003 μm or greater and 0.1 μm or smaller." Office Action at page 3. The Examiner then conceded that "Cabral, Jr. fail to teach a power supply voltage and an SOI impurity concentration." Office Action at page. 3. The Examiner then applied Hu as teaching a power supply voltage of 0.6 V. The Examiner then applied Hirano as teaching "an impurity concentration of an SOI film in the order to magnitude of $10^{17}/\text{cm}^3$." Office Action at page 3. The Examiner concluded at page 4 of the Office Action that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the semiconductor device of Cabral, Jr. et al. with the power supply voltage of Hu et al. and the SOI concentration of Hirano to provide a semiconductor device capable of suppressing delay in operation."

The Examiner has cited no teaching, suggestion or recognition for combining the three references as suggested by the Examiner to form "a semiconductor device capable of suppressing delay in operation". On the contrary, the Examiner appears to be impermissibly using hindsight, that is, using the present applicants' disclosure to provide a motivation for combining the references, which motivation is wholly lacking from the Examiner's citations to the references.

For example, the Examiner appears to have cited no portion of Hu that suggests that the use of 0.6 V in the Cabral structure will provide "a semiconductor device capable of suppressing delay in operation." Similarly, the Examiner cited no portion of Hirano that suggests that the use

of an impurity concentration of $10^{17}/\text{cm}^3$ in the Cabral structure will provide "a semiconductor device capable of suppressing delay in operation." The Office Action does not appear to set forth an explanation of why features such as the voltage in Hu or the impurity concentration in Hirano are the only features one would modify in Cabral to "suppress delay in operation." The Examiner did not appear to establish why one of ordinary skill would only combine certain features of the references and whether such a combination would likely be successful. For example, the Examiner cited no portion of the art that explains why one would choose to combine the specific impurity concentration cited by the Examiner in Hirano with Cabral and not also combine other features of Hirano with Cabral. Absent such guidance, one of ordinary skill would not know which features of Hirano should be combined with Hu and Cabral. The only basis the Examiner has provided for the selected features to combine is that the features are found in applicant's disclosure and claims.

In sum, applicant respectfully submits that the Examiner has not met the proper burden to establish a suggestion or motivation for the desirability of the proposed modifications and combination of references. As stated by the Federal Circuit, "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)(emphasis added). The Examiner's comments and citations regarding ranges and general conditions of a claim do not rise to the level of the particular findings why the skilled artisan would make the proposed combination in this case because the general conditions of the claims do not appear to be found or suggested in a cited reference. Instead, the Examiner appears to have used the present application as a roadmap and has picked individual features that are found in unrelated aspects of three different references and combined these features in order to attempt to reconstruct the claims invention.

That individual features are found in different references does not establish a motivation for the combination of the features as recited in the claims. Absent evidence to indicate that one of ordinary skill would have a logical reason (other than hindsight based on the disclosure and claims of the present application) to make the specific proposed combination, and evidence to indicate a likelihood that that references can be successfully combined as suggested, the Examiner's rejection is improper.

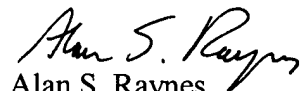
To establish a prima facie case of obviousness, there should be a suggestion or motivation in the art to modify the reference or to combine reference teachings, there should be a reasonable expectation of success, and the reference(s) must teach all the claim limitations. MPEP section 706.02(j). Applicant respectfully submits that the Examiner's citations to the art are insufficient to satisfy the criteria above. For at least the above reasons, the rejection of claims 1-15 should be withdrawn.

New dependent claim 16 has been added. Support for the amendment may be found in the specification at, for example, page 8, lines 14-20, page 9, lines 24-25, and in Fig. 1.

The Examiner made various comments concerning the obviousness of certain features of the present invention. Applicant respectfully disagrees. In addition, the Examiner's comments that have not been discussed above are deemed moot at this time in view of the above response.

Applicant respectfully submits that claims 1-16 are in patentable form. Reexamination and reconsideration are respectfully requested. If, for any reason, the application is not in condition for allowance, the Examiner is requested to telephone the undersigned to discuss the steps necessary to place the application into condition for allowance.

Respectfully submitted,



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September 3, 2003
(Date)